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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
09/990,670	11/16/2001	Thomas Hicks	6414-61471	2776

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EXAMINER	
TSOY, ELENA	

ART UNIT	PAPER NUMBER
1762	

DATE MAILED: 01/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No.	Applicant(s)	
09/990,670	HICKS, THOMAS	
Examiner	**Art Unit**	
Elena Tsoy	1762	

Office Action Summary

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *4-6 and 19-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4-6, 19-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *0104*.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 15, 2003 has been entered.

Response to Amendment

Amendment filed on December 15, 2003 has been entered. Claims 1-3, 7-18 have been cancelled. New claims 19-21 have been added. Claims 4-6, 19-21 are pending in the application.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Cliffe (US 4,528,232) in view of Taylor et al (US 5,672,413).

Cliffe discloses a process of producing a strip for covering window in a car comprising applying to a clear cling polyvinyl chloride film (See column 1, lines 37-42) a *translucent* colored ink (See column 1, lines 49-50). The cling strip self adheres to window glass (non-porous) surface via static cling (through cohesion and atmospheric pressure) (See column 1, lines

37-41). The strip can be printed also with a name, slogan, logo or the like (translucent colored image), and this may be done in reverse before the strip is overprinted with a graduated dot pattern (See column 1, lines 62-64).

Cliffe fails to teach that the cling vinyl film has thickness in the range of 4-10 mils.

Taylor et al teach that polyvinyl chloride film about 50-150 microns thick (2-6 mils) commonly known as cling vinyl or static cling vinyl are flexible and can be used for carrying an image thereon to produce self-adhering stickers for automobile windows (self-adhering window covering), decals, etc. (See column 4, lines 27-31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a polyvinyl chloride film having thickness in the range of 2-6 mils in a process of Cliffe with the expectation of providing the desired self-adhering printed window covering since Taylor et al teach that cling vinyl or static cling vinyl having thickness of 2-6 mils can be used for carrying an image thereon to produce stickers for automobile windows (self-adhering window covering), decals, etc.

It is the Examiner's position that a cling strip for covering window is in fact window covering as claimed because area of coverage is not recited by the claim. It is held that during patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). The broadest reasonable interpretation of the

claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

It is also the Examiner's position that a window covering of Cliffe in view of Taylor et al would have all claimed properties such as allowing light pass through but diffusing it, since window covering is produced by a process identical or substantially identical processes to that of claimed invention.

3. **Claims 4-6, 19-21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Taylor et al (US 5,672,413) and Cliffe (US 4,528,232), further in view of Rega et al (US 6,054,208) and GB 2324381, and further in view of advertisement for Solar Stat (admitted prior art with no date).

Charley et al disclose a process of producing window decals comprising applying a printed colored design 20 through lithographic offset printing process (See column 1, lines 21-35) to a clear or translucent cling vinyl film 16 (See column 2, lines 45-55) of a film material 14, then covering with a very thin layer of *translucent* varnish 36 (See column 2, lines 23-24, 55-58), thereby forming a *translucent* cling decal for covering window (See column 4, lines 8-9). The cling decal self adheres to window glass (non-porous) surface via static cling (through cohesion and atmospheric pressure) by peeling back the carrier 18 from the film 16 and pressing the film 16 to the glass surface (See column 4, lines 6-15). Charley et al further teach that inks are of Werneke Series (See column 3, lines 13-22), and the varnish is UV-curable varnish (See column 3, lines 20-27).

As to claims 4, 19, Charley et al fails to teach that: (i) the translucent cling vinyl film 16 has thickness in the range of 4-10 mils; (ii) the printed colored design 20 is translucent.

(i), Taylor et al are applied here for the same reason as above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a translucent cling vinyl film 16 having thickness in the range of 2-6 mils in a film 14 of Charley et al with the expectation of providing the desired self-adhering printed window covering since Taylor et al teach that cling vinyl or static cling vinyl having thickness of 2-6 mils can be used for carrying an image thereon to produce stickers for automobile windows (self-adhering window covering), decals, etc.

(ii), Cliffe teaches that *translucent* colored ink (See column 1, lines 49-50) can be used for producing a translucent colored image on a clear cling polyvinyl chloride film (See column 1, lines 37-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a translucent colored ink for printing a colored image on a clear cling polyvinyl chloride film in Charley et al with the expectation of providing the desired translucent colored image since Cliffe teaches that translucent colored ink can be used for producing a translucent colored image on a clear cling polyvinyl chloride film.

Charley et al in view of Taylor et al and Cliffe fail to teach that inks are sunfast UV inks; and UV-curable varnish contains UV absorber and a hardening agent.

Rega et al teach that UV absorber added to UV curable systems including UV inks provides weathering protection (See column 14, lines 47-63).

GB 2324381 teaches that the use of a crosslinking (hardening) agent in a coating composition improves scratch resistance by promoting crosslinking upon exposure to UV light (See page 6, lines 15-21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have added UV absorber to UV ink and to UV-curable varnish, and a hardening agent to UV-curable varnish in a colored cling decal of Charley et al in view of Taylor et al and Cliffe with the expectation of providing the colored cling decal with desired UV absorbing properties for weathering protection, as taught by Rega et al, and the desired improved scratch resistance, as taught by GB 2324381.

Charley et al in view of Taylor et al and Cliffe, further in view of Rega et al and GB 2324381 fail to teach that: (i) the window covering protects the interior contents from harmful effects of UV-light (Claims 5, 6, 20, 21); (ii) a printed colored image is assembled from individual pieces (Claims 6, 21).

The advertisement for Solar Stat teaches that the interior contents can be protected from harmful effects of UV-light by covering all surface of window with UV absorbing film.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have covered all surface of window with UV absorbing colored cling decal of Charley et al in view of Taylor et al and Cliffe, further in view of Rega et al and GB 2324381 so that a printed colored image on a window is assembled from individual pieces with the expectation of providing the desired protection of the interior contents from harmful effects of UV-light, as taught by the advertisement for Solar Stat.

As to claimed recited properties, it is the Examiner's position that the window covering of Charley et al in view of Taylor et al and Cliffe, further in view of Rega et al and GB 2324381, and further in view of advertisement for Solar Stat would have properties substantially identical

to those of claimed invention since it is produced by a process identical or substantially identical to that of claimed invention.

Response to Arguments

4. Applicant's arguments with respect to claims 4-6 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30, Mo-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for all communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

ETsoy

Elena Tsoy
Examiner
Art Unit 1762

January 7, 2004